

REMARKS/ARGUMENTS

Claims 1-8, 11-13 and 16-18 are pending in the present application. Claims 1, 8, 11, 13, 16 and 18 have been amended, and Claims 9, 10, 14, 15, 19 and 20 have been cancelled, herewith. Reconsideration of the claims is respectfully requested.

I. 35 U.S.C. § 101

Claims 16-20 stand rejected under 35 U.S.C. § 101 as being directed towards non-statutory subject matter. This rejection is respectfully traversed.

Claim 16 has been amended to recite that the computer program product is tangibly encoded in a computer readable medium and operable in a data processing system for providing dynamic access decision information retrieval, as specifically allowed for per the requirements of MPEP 706.03(a) and 2106. See, in particular, MPEP 2106(IV)(B)(1)(a) where it states:

“A claimed computer-readable medium encoded with a data structure defines structural and functional interrelationships between the data structure and the computer software and hardware components which permit the data structure's functionality to be realized, and is thus statutory. See *Lowry*, 32 F.3d at 1583-84, 32 USPQ2d at 1035.”

Accordingly, as Claim 16 expressly recites a computer program product encoded in a computer readable medium and operable in a data processing system for providing dynamic access decision information retrieval, it is shown that Claim 16 (and similarly for Claims 17-20) is directed to statutory subject matter, pursuant to both judicial case law and the USPTO's own MPEP rules.

Still further, Claim 16 explicitly recites a computer program product encoded in a computer readable medium and operable in a data processing system for providing dynamic access decision information retrieval, which is either a ‘manufacture’ or a ‘composition of matter’, both of which are statutorily recognized subject matter¹. In addition, since Claim 16 explicitly recites a computer program product encoded in a computer readable medium and operable in a data processing system, such claim

¹ 35 U.S.C. 101 Inventions patentable.

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

does *not* fall within one of the three judicially determined exceptions of: natural phenomenon, law of nature or abstract idea (see, e.g., MPEP 2106 and in particular MPEP 2106(IV)(B) and (C)), but instead is limited to a practical application in the technological arts². Thus, it is further shown that Claim 16 is statutory under 35 U.S.C. § 101 as the invention recited therein does not fall within a judicial exception, but instead is limited to a practical application in the technological arts.

Therefore, the rejection of Claims 16-20 under 35 U.S.C. § 101 has been overcome.

II. 35 U.S.C. § 102, Anticipation

Claims 1-3, 6, 7, 11, 12, 16 and 17 stand rejected under 35 U.S.C. § 102 as being anticipated by Davis et al. (U.S. Patent No. 5,432,948). This rejection is respectfully traversed.

Claim 1 is directed to a technique for transliteration of text in Indian languages. The cited reference provides no capability for transliteration of text in multiple Indian languages. In rejecting Claim 1, the Examiner states the Indian language transliteration is described by Davis at col. 11, lines 57-61 and col. 12, lines 55-56. Applicants urge that there, Davis states:

TRuleBasedTransliterator is derived from TTransliterator. It uses a set of context-sensitive rules to transform text, and a parallel set to reverse this action. These rules are designed such that a knowledgeable non-programmer can edit them for localization. Roman rule-based transliteration is available for Japanese (kana), Hebrew, Arabic, Greek, Russian, and Devanagari.

As can be seen, there is no mention of transliteration of text in multiple Indian languages. Applicants have amended Claim 1 to further emphasize this distinction (intra-Indian language transliteration). These claimed features advantageously provide assistance for Indian-based languages that have a multiplicity of dialects due to regional idiosyncrasies, where residents within the country itself may find it difficult to understand scripts/dialects that originate within their own country (Specification page 7, line 25 – page 10). Per the features of Claim 1, it is possible to provide multiple Indian-language based transliterations, thereby advantageously providing a many-to-many or many-to-one transliteration, whereas prior techniques merely contemplated a one-to-one transliteration capability (Specification page 8, lines 11-21).

Further, the cited reference does not teach a user profile that specifies the target of the transliteration. In rejecting the user profile aspect of Claim 1, the Examiner states that Davis teaches that the transliteration is based on a set of rules at Davis col. 5, lines 6-15 and Figure 5. Applicants urge that while this Davis cited passage describes rules that are used when substituting characters/symbols, these

² Only when the claim is devoid of any limitation to a practical application in the technological arts should it be rejected under 35 U.S.C. § 101. Compare *Musgrave*, 431 F.2d at 893, 167 USPQ at 289; *In re Foster*, 438 F.2d 1011, 1013, 169 USPQ 99, 101 (CCPA 1971).

rules do not describe or define the actual language that is to be used in the transliteration process – instead providing a one-to-one mapping (Davis Figure 5, Source/Result). Applicants have amended Claim 1 to further emphasize this distinction with respect to the user profile.

Applicants have further amended Claim 1 to overcome the rejection of such claim, to specifically recite look-up table features, which are separate and distinct from the claimed user profile, that are not disclosed by any of the cited references. Thus, it is urged that the above articulated amendments to Claim 1 have overcome the present rejection of such claim.

Applicants traverse the rejection of Claims 2, 3, 6, 7, 11, 12, 16 and 17 for similar reasons to those given above with respect to Claim 1.

Therefore, the rejection of Claims 1-3, 6, 7, 11, 12, 16 and 17 under 35 U.S.C. § 102 has been overcome.

III. 35 U.S.C. § 103, Obviousness

Claims 4 and 5 stand rejected under 35 U.S.C. § 103 as being unpatentable over Davis et al., in view of Microsoft (*Computer Dictionary*). This rejection is respectfully traversed.

Applicants initially traverse the rejection of Claims 4 and 5 for similar reasons to those given above with respect to Claim 1, as the additional cited Computer Dictionary reference does not overcome the teaching deficiencies identified above with respect to amended Claim 1 and the cited Davis reference.

Still further, it is urged that the Examiner is using impermissible hindsight analysis in rejecting Claim 4. The Examiner states that a person of ordinary skill in the art would have been motivated to combine the teachings of these two references since this would allow for the transliteration of World Wide Web documents. Applicants urge error, as neither of these references contemplates or otherwise provide any suggestion or other motivation to modify such teachings to provide transliteration of World Wide Web documents. Instead, it is Applicants own disclosure that provides such motivation (Specification page 9, 1st full paragraph; page 13, 2nd full paragraph). Importantly, Davis is keen on providing an all-in-one type of system such that local rules can be used to transliterate text as it is input in real time (Abstract; col. 2, lines 18-22). Thus, a person of ordinary skill in the art would not have been motivated to modify such teachings in accordance with the features of Claims 4 and 5. Therefore, it is further urged that Claims 4 and 5 have been erroneously rejected using impermissible hindsight analysis.

Therefore, the rejection of Claims 4 and 5 under 35 U.S.C. § 103 has been overcome.

IV. 35 U.S.C. § 103, Obviousness

Claims 8-10, 13-15 and 18-20 stand rejected under 35 U.S.C. § 103 as being unpatentable over Davis et al., in view of Miyao et al. (U.S. Patent No. 4,774,666). This rejection is respectfully traversed.

Applicants initially traverse the rejection of these claims for similar reasons to those given above with respect to Claim 1, as the additional cited Miyao reference does not overcome the teaching deficiencies identified above with respect to amended Claim 1 and the cited Davis reference.

Still further, Claim 8 has been amended to include the features previously recited in Claims 9 and 10 (and thus Claims 9 and 10 are being cancelled herewith, without prejudice or disclaimer). None of the cited references contemplate *transliterations of synonyms*. In rejecting the synonym transliteration features previously recited in Claims 8-10, the Examiner states that Davis discloses transliterating any selected text, and thus it would have been obvious to transliterate Miyao's synonyms. Applicants urge error, in that the Examiner is using impermissible hindsight analysis in such rejection as neither reference contemplates transliteration of synonyms. Thus, the only motivation for making this combination must be coming from Applicants' own disclosure, which is impermissible hindsight analysis. As the Federal Circuit outlines in *Ruiz v. A.B. Chance Co.*, 357 F.3d 1270, 1275 (Fed. Cir. 2004), in making the assessment of differences between the prior art and the claimed subject matter, section 103 specifically requires consideration of the claimed invention "as a whole". Inventions typically are new combinations of existing principles or features. *Ervyl. Designs, Ltd. V. Union Oil Co.*, 713 F.2d 693, 698 (Fed. Cir. 1983) (noting that "virtuall all [inventions] are combinations of old elements"). The "as a whole" instruction in title 35 prevents evaluation of the invention part by part. *Ruiz*, 357 F.3d at 1275. Without this important requirement, an obviousness assessment might successfully break an invention into its component parts, then find a prior art reference corresponding to each component. *Id.* This line of reasoning would import hindsight into the obviousness determination by using the invention as a roadmap to find its prior art components. Further, this improper method would discount the value of combining various existing features or principles in a new way to achieve a new result – often the essence of invention. *Id.* Contrary to this reasoning, section 103 requires assessment of the invention as a whole. *Id.* This "as a whole" assessment of the invention requires a showing that an artisan of ordinary skill in the art at the time of the invention, confronted by the same problems as the inventor and with no knowledge of the claimed invention, would have selected the various elements from the prior art and combined them in the claimed manner. *Id.* In other words, section 103 requires some suggestion or motivation, before the invention itself, to make the new combination. *Princeton Biochemicals, Inc. v. Beckman Coulter, Inc.*, Federal Circuit, No. 04-1493, June 9, 2005. In 1983, the late Judge Howard Markey made the following observation in *W.L. Gore & Associates Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), which states the basic interest protected by this test—improper hindsight analysis of prior art:

To imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall

victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.

Applicants expressly show that a person of ordinary skill in the art would *not* have been motivated to modify the teachings of Davis to provide the synonym transliteration features of Claim 8 due to the unique object-oriented data processing system provided by Davis, whereby rules instantiated in objects are used to match user-provided textual input in order to display transliterated text in real-time. Such a system is not conducive to providing a synonym capability, with associated transliteration thereof. For example, the Davis system is specifically oriented to process individual characters, and not words (col. 5, lines 15-67). While Davis does accommodate processing of a plurality of text characters (called 'text ranges'), again the rule processing and matching is at a text character level, and not at a word level (see, e.g. Davis col. 6, lines 55-64 and the detailed flow diagram of Figure 2, where characters are individually processing 'one-by-one'). Individual text characters do not have synonyms like words do. Because Davis does not contemplate use of the rule system to process words, it similarly has not capability to process synonyms for words, or associated transliteration of such (missing) synonyms. Thus, it is urged that a person of ordinary skill in the art would not have been motivated to modify the teachings of Davis to process synonyms or an associated transliteration thereof, as such a change would effectively eviscerate the entire expressed purpose of the Davis' character-driven rules based object-oriented system. Thus, it is urged that Claim 8 is not obvious in view of the cited references, as the only motivation for modifying Davis must therefore be coming from Applicants' own disclosure, which is impermissible hindsight analysis.

Applicants traverse the rejection of Claims 13-15 and 18-20 for similar reasons to those given above with respect to Claim 8.

Therefore, the rejection of Claims 8-10, 13-15 and 18-20 under 35 U.S.C. § 103 has been overcome.

V. Conclusion

It is respectfully urged that the subject application is patentable over the cited references and is now in condition for allowance. The Examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the Examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

DATE: August 9, 2007

Respectfully submitted,

/Wayne P. Bailey/

Wayne P. Bailey
Reg. No. 34,289
Yee & Associates, P.C.
P.O. Box 802333
Dallas, TX 75380
(972) 385-8777
Attorney for Applicants